

# Best Available Copy

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## REMARKS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-18 and 20-22 are pending, of which claims 1, 7, 12, 15, 17, and 22 are independent, claim 22 being added to provide Applicants with the protection to which they are deemed entitled.

The pending claims are amended for clarity. Claims 12 and 17 are further amended to indicate that the functionality modified by the update license key is the data storage capacity of the computer entity, a limitation previously recited in claim 19, which is now cancelled.

Applicants traverse the rejection of claims 15 and 16 under 35 U.S.C. §102(b) as being anticipated by Bolan et al. (U.S. 5,226,137). While the Office Action contends the Abstract and column 5, line 5, through column 6, line 67, of Bolan inherently includes data defining an amount of data storage capacity licensed for use by a computer entity, Applicants respectfully note that a *prima facie* case of inherency has not been established.

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter

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is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

Moreover, consideration of Bolan indicates the reference does not inherently include the claim 15 requirement of data defining an amount of data storage capacity licensed for use by a computer entity.

The Office Action equates a secure subkey command (e.g., GET SECURE DATA) with Applicants' license key. Each secure subkey command is a 24-bit word, which includes three data fields: the identity of the subkey to be accessed; the starting address for the data transfer operation; and the type of transfer operation to be performed, e.g., read or write data (column 4, lines 48-52). The secure subkey command can, therefore, be regarded as a license key that includes data uniquely identifying a computer entity (i.e., a subkey). However, the secure subkey command does not include data defining an amount of data storage *capacity* licensed for use by the computer entity (i.e., the

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subkey). For example, the secure subkey command cannot be used to increase or decrease the size of the secure data field from 384 bits. In Bolan, the size of the identification, password, and secure data fields of each subkey must remain constant to enable different host devices to access the correct data fields. There is nothing in the relied-on portions of Bolan to support the conclusion that a secure subkey can be used to change the **capacity** of a subkey.

Therefore, contrary to the assertion in the Office Action, Bolan does not inherently include a license key having the features of claim 15. In particular, Bolan fails to disclose a license key that is capable of changing the data storage capacity of a computer entity. Hence, Bolan does not anticipate the subject matter of claim 15. Since claim 16 depends on claim 15, Bolan fails to anticipate this claim, as well.

Applicants traverse the rejection of claims 12-14 under 35 U.S.C. §103(a) as being unpatentable over Bolan in view of Westfall et al. (U.S. 5,155,849).

The Office Action relies on Westfall for features admittedly missing from Bolan, including modifying computer entity functionality, checking whether the computer entity is capable of modifying functionality, and enabling computer entity functionality modification. However, Bolan describes an electronic key for storing secure data, while Westfall describes a photocopier having different language files

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for controlling the language of text displayed to the user. Clearly, the disclosures of Bolan and Westfall relate to two very different technical fields, and one of ordinary skill would not consider the disclosure of Bolan in combination with that of Westfall. In particular, it would not be obvious for one of ordinary skill in the art of secure data storage to consider documentation relating to photocopiers or printers. Since, contrary to the assertion in the Office Action, it would not be obvious to one of ordinary skill in the art to combine the disclosures of Bolan and Westfall, it is respectfully submitted the subject matter of claim 12 is patentable.

In one Federal Circuit case dealing with the issue of non-analogous art, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), an Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The USPTO relied on a reference which disclosed a hook-and-eye fastener for use in garments, reasoning that all hooking problems are analogous. However, the court held the reference was not within the field of Applicant's endeavor and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for

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garments. On appeal, the Commissioner argued that a disengageable catch is a common everyday mechanical concept, but the court held the Commissioner did not explain why a "catch" of unstated structure is such a concept and why it would have made the claimed invention obvious.

In *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), involving patent claims directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers, the court held reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. The reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes can be added or replaced, whereas the claimed invention involved compact modular memories. The finding that the reference was non-analogous was supported by substantial evidence, including the fact that the memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories.

The cases that have held art from somewhat differing fields to be combinable have generally relied on similarity of problem. In the

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present case, the Office Action does not indicate that similar problems existed in the Bolan computer field and the Westfall copier field. Rather, after becoming aware of Applicants' disclosure, the Examiner set about to find references allegedly disclosing different features of claim 12 with the aid of impermissible hindsight. This is an improper way to combine references.

Even if one of ordinary skill were to consider Bolan in combination with Westfall, s/he would not arrive at the subject matter of amended claim 12. As acknowledged in the Office Action, Bolan fails to disclose a method of providing a functionality upgrade that includes receiving a request to modify the functionality of a computer entity, checking in a database whether the functionality of the computer entity is capable of being modified, and enabling the functionality of the computer entity to be modified. In other words, Bolan fails to describe the vast majority of the features of claim 12.

Westfall describes a conventional software upgrade wherein the control software used to control a photocopier is updated by transferring upgrade files from a floppy disk to a hard disk of the photocopier. The Office Action suggests it would have been obvious to combine the disclosures of Bolan and Westfall to arrive at the features of claim 12. However, it does not appear to be possible to upgrade the functionality of the electronic key of Bolan as proposed in the Office Action. The electronic key of Bolan is essentially a memory stick, the data contents of which are password-protected. The electronic key has

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no display, no hard disk storing control software, and no floppy drive for receiving a disk storing upgrade files. Therefore, it would not have been obvious to one of ordinary skill in the art to have upgraded Bolan's electronic key by using the approach of Westfall.

As noted, claim 12 is amended to indicate the data storage capacity of the computer entity is the functionality that is upgraded. As noted in connection with claim 15, Bolan does not upgrade the data storage capacity of the electronic key, nor is there any mention in Westfall of upgrading the data storage capacity of the photocopier. Accordingly, the combination of Bolan and Westfall does not render the features of claim 12 obvious. Since claims 13 and 14 depend on claim 12, Bolan and Westfall fail to render obvious these claims, as well.

Applicants traverse the rejection of claims 1, 3, 5, 7, 10, 17, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bolan in view of Westfall and Dubats (U.S. 5,559,496).

As noted in connection with claim 12, the disclosures of Bolan and Westfall relate to two very different technical fields. The Dubats remote petrol system for collating data relating to low density traffic conditions relates to yet a third disparate technical field that is different from both Bolan and Westfall. One of ordinary skill in the art would not consider the disclosure of Bolan in combination with Westfall and Dubats. In particular, it would not be obvious to one of ordinary skill in the art of secure data storage to consider

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documentation relating to photocopiers **and** systems for monitoring traffic conditions. Since it would not have been obvious to one of ordinary skill in the art to combine the disclosures of Bolan, Westfall, and Dubats, the subject matter of independent claims 1, 7, and 17 is patentable over these references.

Even if Bolan, Westfall, and Dubats are considered in combination, the subject matter of claims 1, 7, and 17 is not rendered obvious. The following discussion with respect to claim 1 is applies equally to amended independent claims 7 and 17.

Item 9 of the Office Action contends Bolan describes a data storage device and first license key data that allows partitioning of the data storage device. Indeed, Bolan describes an electronic circuit having a memory array that is partitioned into three subkeys and a scratch pad. Mapping of the memory array into three subkeys and a scratch pad is achieved by means of a lookup RAM that stores the register addresses of the different partitions (see column 3, lines 3-9; column 10, lines 45-49; and column 12, lines 5-13). The data stored by the lookup RAM may be regarded as providing a first amount of data storage capacity (e.g., the scratch pad) that is lower than the total amount of data storage capacity (e.g., the scratch pad and the three subkeys). Accordingly, the lookup RAM may be regarded as storing license key data that provides a first amount of data storage capacity lower than the total amount of data storage capacity. A user is



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nevertheless able to access all partitions of the memory array, i.e., the user is licensed to use the total data storage capacity provided by the memory array. Consequently, the lookup RAM does not provide a first amount of **licensed** data storage capacity that is **lower** than the total data storage capacity. Instead, the lookup RAM licenses access to all partitions of the memory array. Therefore, it is incorrect to assert, as in item 9 of the Office Action, that Bolan describes first license key data that provides a first amount of **licensed** data storage capacity that is **lower** than the total data storage capacity. However, to clarify the point, independent claims 1 and 17 are amended to indicate the licensed data storage capacity is **only lower** than the total data storage capacity.

As acknowledged in the Office Action, the data stored in the RAM lookup table described by Bolan fails to include upgrade flag data. However, the Office Action turns to Westfall to describe this feature. As defined in claim 1, the upgrade flag data forms part of the license key data. Although Westfall describes an upgrade-in-progress flag, this flag is used only to indicate that a software upgrade of the photocopier is in progress. The upgrade-in-progress flag does not form part of a license key that provides a partitioned amount of data storage capacity. Furthermore, it is not at all obvious how Westfall's upgrade-in-progress flag should be incorporated in the lookup RAM described by Bolan. If this rejection is maintained, the Examiner must

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indicate how one of ordinary skill in the art would incorporate the Westfall flag in Bolan's RAM.

The upgrade flag data set forth in claim 1 determines whether the partitioned data storage capacity can be increased. The upgrade-in-progress flag described by Westfall does not determine whether the data storage capacity of the photocopier can be increased. Moreover, the data storage capacity of each partition of the electronic key described by Bolan is fixed at 512 bytes. There is no suggestion in Bolan of how the data storage capacity of a particular partition might be increased. Dubats, like Bolan and Westfall, fails to disclose or suggest a computer entity having a data storage capacity that can be increased.

It is, therefore, submitted that claim 1 is not rendered obvious since none of Bolan, Westfall, or Dubats describes a computer entity in which a first amount of licensed data storage capacity is provided, which can be increased by means of upgrade flag data.

In item 9, the Office Action also states that one of ordinary skill would have obviously considered combining Bolan and Westfall so as to install customer language options on the electronic key. The only data transferred from the electronic key is data stored in the memory array. The electronic key does not, for example, provide any user messages or the like. Accordingly, not only is there no motivation for installing language options onto the electronic key, but it also does not appear to be obvious to one of ordinary skill how to install language options. Furthermore, any attempt to install language

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options would fail to change the data storage capacity of the electronic key.

Accordingly, independent claims 1, 7, and 17 are allowable. Claims 2-6, 8-11, 13, 14, 16-18, and 21 are also allowable due to dependence, directly or by extension, on allowable independent claims, as well as for the additional limitations provided by these claims.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of the application are, therefore, deemed in order, and such action is respectfully requested.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any prescribed fees not otherwise provided for, including application processing, extension, and extra claims fees, to Deposit Account No. 08-2025.

Respectfully submitted,  
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